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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,885	07/12/2002	Pierre Bertrand	032326-170	6228
21839	7590	12/02/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			LEE, SEUNG H	
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ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			2876	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,885

Applicant(s)

BERTRAND ET AL.

Examiner

Seung H Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the response filed on 02 September 2004, which has been entered in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10-12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis (EP 0,350,179, of record) in view of Kohama et al. (US 6,412,701, of record)(hereinafter referred to as 'Kohama').

Jarvis teaches a method of manufacturing portable electronic tokens such as a smart card type comprising a copper layer (7) having a integrated circuits (1) and an inductive coils (4) serving as an antenna, wherein the integrated circuits and the inductive coils serves as functional elements and moulded plastics (e.g., dielectric material) (8) bonded to all the circuits therewith in which the copper layer and the moulded plastics together serves as a support sheet, the resin, components, and a labels (6) serving as a covering layer and fluid serving as flowable material are fed or extruded into a die to form continuous strips of completed cards then separated as desired, the integrated circuits and the coils are preinstalled on the copper layer prior to

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fed into the die, 2 pairs of pinch rollers (12 and 13) locating opposing side of the labels to mark the ends of each labels, injecting of the mouldable plastic materials (see Figs. 1-3; col. 1, line 7-col. 4, line 10).

However, Jarvis fails to particularly teach that the smart card type is contactless type, the support sheet is a conductive grille, the copper layer is packaged in the form of a coil to be unwound continuously, and a chip and the entire connection wire are embedded a resin.

Kohama teaches a method of manufacturing a contactless IC card comprising an IC module (10) drawn off from a roller (71) continuously wherein the IC module having an antenna (2) in grille form, wherein a chip (1) connected to the antenna via terminals (1a) in which the chip and the antenna is embedded in a resin (see Figs. 1-3 and 17; col. 8, line 38-col. 10, line 22; col. 18, line 43-col. 19, line 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kohama to the teachings of Jarvis in order to speed up the production rate of the smart card by supplying the IC module having necessary circuits installed thereon continuously from the roller, and therefore an obvious expedient.

4. Claims 9, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis as modified by Kohama, and further in view of Melzer et al. (US 6,305,609, of record)(hereinafter referred to as 'Melzer').

The teachings of Jarvis/Kohama have been discussed above.

Although, Jarvis/Kohama teaches that the method of manufacturing the IC card, they fail to particularly teach that the support sheet has at least one opening through which the bottom and top layers are joined.

However, Melzer teaches a process for manufacturing data card comprising a carrier film (8) having a module element (5), a top layer (3), and a bottom layer (4) wherein the carrier film containing a cavities or depressions (13) serving as an opening in which leveling material (14) fills the cavities for joining the module element and the top layer and the bottom layer (see Figs. 1-2; Abstract; col. 6, line 65-col. 8, line 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Melzer to the teachings of Jarvis/Kohama in order to improve a shape of the data card or the smart card by evening out the height difference due to the substructures of the module elements between the top layer and the bottom layer using leveling material therewith.

Although, Jarvis as modified by Kohama fail to particularly teach the location of the opening, however, it would have been an well known in the art at the time the invention was made to realize that the coils area are significantly greater then the area occupied by the chip as taught by Melzer (col. 2, lines 29+) and as shown in figure 1 of Kohama.

Response to Arguments

5. Applicant's arguments filed 02 September 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that *"The Office Action does not indicate how this teaching relates to the specific language of the rejected claims...."* (see page 6, line 23+), Jarvis fails to particularly teach how to supply components on the card even he teaches the general teaching of manufacturing the card using extrusion method. However, Kohama discloses a method and system for supplying components such as IC modules, antennas, etc. Therefore, it would have been an obvious to one of ordinary skill in the art at the time the invention was made to modify the method and the system of Jarvis having a roller for supplying necessary components continuously as discussed in paragraph 3 above.

In response to applicant's argument that *"...the label 6 are not extruded as a flowable material."* (see page 7, line 15+), the Examiner respectfully disagrees with the applicant wherein Jarvis discloses that manufacturing disclosed token comprises a injection of the mouldable plastic materials as discussed in paragraph 3 above.

In response to applicant's argument that *"...it does not disclose that the material that forms the covering layers for data cards, namely the layer 3 and 4, is presented within the theses cavities to form a monolithic construction..."* (see page 8, line 9+), the Examiner respectfully disagrees with the applicant wherein Melzer discloses a filling of cavities existing between top and bottom layer in which such filling serves as a monolithic construction.

Conclusion


Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax-phone number for this group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [seung.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Seung H. Lee
Art Unit 2876
November 27, 2004


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800